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09/602,923	06/23/2000	Bernard Duroux	BRI-00039	1036

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EXAMINER

SHAHER, RICKY D

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 14

Application Number: 09/602,923

Filing Date: June 23, 2000

Appellant(s): Duroux et al

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GROUP 2800

Philip R. Warn

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 28, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

I. Whether claims 1, 6 and 7 are unpatentable under 35 U.S.C. 103(a) over Enomoto et al ('693) in view of Tomiyoshi ('030) or Schenk et al ('753).

II. Whether claims 1-7 are unpatentable under 35 U.S.C. 103(a) over Valentino ('167) in view of Tomiyoshi ('030) or Schenk et al ('753).

(7) Grouping of Claims

The rejection of claims 1-7 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,012,693	ENOMOTO et al	05-1991
5,953,167	VALENTINO	09-1999
6,204,753	SCHENK et al	03-2001
JP 8-26030	TOMIYOSHI	01-1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims 1, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto et al ('693) in view of Tomiyoshi ('030) or Schenk et al ('753).

Enomoto et al discloses a rearview mirror assembly comprising a base (16), a housing (14), a reflective member (12) and an electric motor (30), wherein said electric motor inherently includes a controller in order to turn the electric motor on or off so as to position the housing from a folded position to an unfolded position or vice-versa, note Fig. 1, except for explicitly stating that the controller is adapted to control the electric motor in such a

manner that the motor operates at a first discrete speed and at a second discrete speed.

Tomiyoshi and Schenk et al each teach it is known to adjust the swing speed of a mirror assembly in the same field of endeavor for the purpose of regulating the operating speed of the mirror assembly.

Therefore, it would have been obvious and/or within the level of one of ordinary skill in the art at the time the invention was made to modify the controller of Enomoto et al to include a typical control circuit, as taught by Tomiyoshi or Schenk et al, in order to adjust the swing speed of the mirror assembly.

As to the limitations of claims 6 and 7, it would have been obvious and/or within the level of one of ordinary skill in the art at the time the invention was made to adjust and/or tailor the swing speed of the mirror assembly to meet user's specifications. Since it has been held that discovering optimum or workable ranges involves only routine skill in the art.

Note In re Aller 105 U.S.P.Q. 233; In re Boesch, 617 F. 2d 272, 205 U.S.P.Q. 215 (CCPA 1980) and In re Reese, 129 U.S.P.Q. 402.

II. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentino ('167) in view of Tomiyoshi ('030) or Schenk et al ('753).

Valentino discloses a rearview mirror assembly comprising a base (128), a housing (124), a reflective member (126), an electric motor (122) and a controller (100,110) including measuring means (220) having a counter (90), note Figures 4, 6-9, 11 and 12, except for explicitly stating that the controller is adapted to control the electric motor in such a manner that the motor operates at a first discrete speed and at a second discrete speed.

Tomiyoshi and Schenk et al each teach it is known to adjust the swing speed of a mirror assembly in the same field of endeavor for the purpose of regulating the operating

speed of the mirror assembly.

Therefore, it would have been obvious and/or within the level of one of ordinary skill in the art at the time the invention was made to modify the controller of Valentino to include a typical control circuit, as taught by Tomiyoshi or Schenk et al, in order to adjust the swing speed of the mirror assembly.

As to the limitations of claims 4-7, it would have been obvious and/or within the level of one of ordinary skill in the art at the time the invention was made to adjust and/or tailor the swing speed of the mirror assembly to meet user's specifications. Since it has been held that discovering optimum or workable ranges involves only routine skill in the art.

Note In re Aller 105 U.S.P.Q. 233; In re Boesch, 617 F. 2d 272, 205 U.S.P.Q. 215 (CCPA 1980) and In re Reese, 129 U.S.P.Q. 402.

(11) Response to Argument

In response to appellant's argument that there is no suggestion or motivation in the prior art to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See In re Fine, 837 F. 2d 1071, 5 U.S.P.Q. 2d 1596 (FED. CIR. 1988) and In re Jones, 958 F. 2d 347, 21 U.S.P.Q. 2d 1941 (FED. CIR. 1992). In this case, the exemplary reference(s) to Tomiyoshi and Schenk et al each clearly teach a controller (i.e. circuit (10) with adjusting means (27), shown in figures 6 and 9, of Tomiyoshi and control device (7) with actuating mechanism (2), shown in figures 1 and 2, of Schenk et al) to selectively control the rotational speed of an electric motor of a door mirror and/or swing (folding) speed of a side view mirror housing, respectively, which would obviously convey to one of ordinary skill in the mirror

art the general knowledge of a door mirror assembly having a controllable swing speed adjustment to avoid impact or collision with an object or body which may damage the mirror assembly. Thus, it certainly would have been obvious and/or within the level of one of ordinary skill in the art at the time the invention was made to modify the controller of Enomoto et al or Valentino to include a controllable swing speed adjustment in order to avoid impact or collision with an object or body which may damage the door mirror assembly. For example, see column 1, lines 40 to 50, column 1, line 61 to column 2, line 29 and column 2, lines 39 to 44 of Schenk et al.

Furthermore, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in anyone or all of the references, rather, the test is what the combined teaching of the references, as a whole, would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208 U.S.P.Q. 871 (CCPA 1981).

I. The appellant argues that the reference to Enomoto et al does not teach a controller adapted to control the electric motor in such a manner that the motor operates at a first discrete speed and at a second discrete speed and that the references to Tomiyoshi and Schenk et al do not teach that the housing is driven at two separate and discrete speeds amounts to arguing the references individually.

The examiner states one cannot show nonobviousness by attacking the references individually where, as here, the rejection is based on a combination of references. Note In re Keller, 642 F. 2d 413, 208 U.S.P.Q. 871 (CCPA 1981) and In re Merck and Co., 800 F. 2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986).

In response to the appellant's statement that the reference to Tomiyoshi fails to

show certain features of applicant's invention, it is noted that the features upon applicant relies (i.e. swing speeds which indicate more than one speed being possible at a given time) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F. 2d 1181, 26 U.S.P.Q. 2d 1057 (Fed. Cir. 1993). Note: The claims do not require more than one speed being possible at a given time. The claims merely requires that the motor is capable of selectively driving the housing about a first speed or a second speed which is greater than the first speed.

In response to appellant statement that the reference to Schenk et al fails to teach a two-speed mirror adjustment system having both speeds determined by the movement of an output shaft of a motor. The examiner is not relying on the reference to Schenk et al to teach a two-speed mirror adjustment system having both speeds determined by the movement of an output shaft of a motor. The examiner is relying on the Schenk et al reference to teach the concept of a side view mirror housing having a controllable speed adjustment for folding said side view mirror housing in order to avoid impact or collision of said side view mirror housing with an object or body. See column 1, lines 40 to 50, column 1, line 61 to column 2, line 29 and column 2, lines 39 to 44 of Schenk et al.

The rejection of claims 6 and 7 stand or fall with claim 1 due to the fact that the appellant's brief does not include a statement that this grouping of claims do not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

II. The appellant argues that the reference to Valentino does not teach a controller adapted to control the electric motor in such a manner that the motor operates at a first discrete speed and at a second discrete speed and that the references to Tomiyoshi and Schenk et al do not

teach that the housing is driven at two separate and discrete speeds amounts to arguing the references individually.

The examiner states one cannot show nonobviousness by attacking the references individually where, as here, the rejection is based on a combination of references. Note In re Keller, 642 F. 2d 413, 208 USPO 871 (CCPA 1981) and In re Merck and Co., 800 F. 2d 1091, 231 USPO 375 (Fed. Cir. 1986).

In response to the appellant's statement that the reference to Tomiyoshi fails to show certain features of applicant's invention, it is noted that the features upon applicant relies (i.e. swing speeds which indicate more than one speed being possible at a given time) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F. 2d 1181, 26 U.S.P.Q. 2d 1057 (Fed. Cir. 1993). Note: The claims do not require more than one speed being possible at a given time. The claims merely requires that the motor is capable of selectively driving the housing about a first speed or a second speed which is greater than the first speed.


In response to appellant statement that the reference to Schenk et al fails to teach a two-speed mirror adjustment system having both speeds determined by the movement of an output shaft of a motor. The examiner is not relying on the reference to Schenk et al to teach a two-speed mirror adjustment system having both speeds determined by the movement of an output shaft of a motor. The examiner is relying on the Schenk et al reference to teach the concept of a side view mirror housing having a controllable speed adjustment for folding said side view mirror housing in order to avoid impact or collision of said side view mirror housing with an object or body. See column 1, lines 40 to 50, column 1, line 61 to column 2,

line 29 and column 2, lines 39 to 44 of Schenk et al.

The rejection of claims 2 to 7 stand or fall with claim 1 due to the fact that the appellant's brief does not include a statement that this grouping of claims do not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


RICKY D. SHAFER
PATENT EXAMINER
ART UNIT 2872

RDS
November 01, 2003

Conferees:

D. Dunn 

B. Sircus 

R. Shafer 